

Remarks

The above Amendments and these Remarks are in reply to the Office Action mailed October 19, 2005.

Claims 1-24 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected claims 12, 17 and 21, and withdrew from consideration claims 1-11, 13-16, 18-20 and 22-23. The Examiner does not explain why claim 22 which depends from claim 12 (and limits the sodium ion concentration) should be withdrawn from consideration. The present response cancels claims 1-24 and adds claims 25-44 leaving for the Examiner's present consideration claims 25-44. Reconsideration of the rejections is requested.

Conversion Claim Chart

old claim number	new claim number
1	-
2	-
3	-
4	-
5	-
6	-
7	-
8	-
9	-
10	-
11	-
12	44
13	-
14 dependent on 12	42 dependent on 28

15 dependent on 3		42 dependent on 28
16		-
17 dependent on 12		29 dependent on 28
18		-
19		-
20		-
21 dependent on 12		31 dependent on 28
22 dependent on 12		30 dependent on 28
23 dependent on 1		31 dependent on 28
24		-

#### Claim Rejection 35 USC 103

Claims 12 and 17 were rejected under 35 USC 103(a) as being unpatentable over US patent 3,764, 692 to Lowenstein (hereinafter '692) in view of US patent 5,536,516 to Moffett et al. (hereinafter '516).

Claim 17 is embodied in current Claim 29 which depends on current Claim 28. Claim 12 is embodied in current Claim 44.

The Examiner states that "[a]lthough '692 teaches weight-loss compositions comprising hydroxycitric acid, sodium or potassium, AND calcium, '692 does not teach the same concentrations as set forth in the instant composition" (emphasis added).

The Examiner refers to '692 where "[i]n preferred embodiments, the hydroxycitric acid-based composition may include salts of sodium or potassium AND can also include calcium or a complex of said salts (column 2, lines 1-8)" Office Action mailed October 19, 2005, page 4, last paragraph, lines 3-5, (emphasis added). The Examiner misquotes and misconstrues Lowenstein. Lowenstein at column 2, lines 3-8 states:

"Preferred salts for this purpose include the alkali metals, e.g., sodium OR potassium; the alkaline earth metals, e.g., calcium; OR complex salts such as ammonium OR substituted ammonium salts such as A mono-, di- OR tri-alkylammonium salt OR A mono-, di- or tri-hydroxyalkylammonium salt" (emphasis added).

In the sentence at column 2, lines 3-8, Lowenstein does not propose “a complex of said salts” as the Examiner suggests, but rather a single complex salt where the precise salt may be one of a number of different “complex salts”. Thus in the sentence after the reference to “complex salts” Lowenstein continues with a descriptive list of what is meant by “complex salts”. In this list Lowenstein uses the singular form “a” (a mono-alkylammonium salt or a mono-hydroxyalkylammonium salt). This reinforces that a single salt was envisaged.

Preceding the above quotation, at column 2, lines 1-2 is the statement that “[t]he garcinia acid may also be utilized in the form of its pharmaceutically acceptable non-toxic basic salt”. Again, Lowenstein uses the singular form of “salt”, not “salts” evidencing the absence of an intent to teach or suggest the subject matter claimed by the Applicant.

In Examples 1-3 and 8-11, Lowenstein uses the term “garcinia acid” and “garcinia acid lactone”. In Example 4, Lowenstein defines these terms as “garcinia acid either in the free acid or lactone form” (column 5, lines 28-29). In Examples 5-7, Lowenstein uses the additional terms garcinia acid lactone dimethyl ester, garcinia acid lactone mono ammonium salt, garcinia acid lactone diethyl ester, and garcinia acid lactone triethyl ester. In all of these examples, the hydroxycitric acid is either the free acid form or a single salt. None of the examples evidence that Lowenstein taught or suggested the claimed subject matter.

In contrast, the Applicants have surprisingly found that “a composition comprising hydroxycitric acid, calcium and potassium or sodium wherein the composition is bound together to form a single molecule”, which has desirable properties that are not present with hydroxycitric acid and a single cation. Specifically, the Applicants found that their invention is highly soluble in water while retaining minimal hygroscopicity. The solubility has obvious benefits in terms of formulating and administering the active agent. The minimal hygroscopicity is desirable because the composition doesn’t hydrate in air and therefore doesn’t degrade or cyclize. The sodium or potassium and calcium salt also unexpectedly has attractive food product qualities including negligible odor, minimal palatability, high solubility and clarity in solution, minimal hygroscopicity, neutral taste and color. These findings are totally unexpected based on the prior art.

Neither ‘692 nor ‘516 teach or suggest the present invention. Specifically, neither ‘692 nor ‘516 teach or suggest “a composition comprising hydroxycitric acid, calcium AND potassium or sodium” (emphasis added). The Applicant respectfully submits that one of

ordinary skill in the art, at the time the invention was made would not have predicted this desirable and valuable composition and thus the invention is non-obvious.

Claims 12 and 17 were also rejected under 35 USC 103(a) as being unpatentable over US patent 5,536,516 to Moffett et al. (hereinafter '516) in view of WO 98/28989 to Karppanen et al. (hereinafter '989).

Claim 17 is embodied in current Claim 29 which depends on current Claim 28. Claim 12 is embodied in current Claim 44.

The Examiner's argument is that '516 teaches snack bars, however, not the same concentrations as set forth in the instant composition. According to '989 calcium and potassium can be added to decrease obesity. Thus the Examiner argues that one of skill in the art would be motivated to produce a weight loss composition comprising an effective amount of hydroxycitric acid, calcium and potassium.

#### '989 Teaches Away

The '989 application actually teaches away from the subject matter of the invention. "A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention". MPEP 2144.05. The Examiner states that "[s]ince, according to '989, the combination of calcium and potassium decreases obesity, one would be motivated to add it to a weight loss composition or formula, such as the one proposed in '516." The Applicant notes that while '989 is directed to mineral salt forms of magnesium, calcium and potassium some embodiments include organic forms of these cations. However, in '989, none of the organic anions are compounds for promoting weight loss. In fact, '989 is silent on combining any of these cations (magnesium, calcium and potassium) with any weight loss anion at all. In fact, '989 teaches combining the mineral salts as seasoning with food items such as bacon and eggs (page 5, line 20-21) or in the composition of biscuit like products, breads and cookies (page 5, line 17-18). These are not weight loss foods. Thus '989 teaches adding cations of mineral salts to normal or fatty foodstuffs. Accordingly, the '989 teaches away from combining cations (magnesium, calcium and potassium) with an anion with a characteristic propensity for itself inducing weight loss.

'989 Does Not Teach or Suggest in Sufficient Detail

The '989 does not teach or disclose the invention in as much detail. Here the question "... is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious". MPEP 2141.02. Combining calcium or potassium mineral (or organic) salts from '989 with the free acid (or sodium) form of hydroxycitric acid according to '516 would not be equivalent to administering the subject matter claimed. Simply mixing these cations with the anion would not have produced a form of hydroxycitric acid that had negligible odor, minimal palatability, high solubility and clarity in solution, let alone a stable form with the reduced hygroscopic properties. The Applicant respectfully submits that unlearned or unintentional mixing of unspecified reagents would not yield the claimed subject matter. In contrast, the Applicants have surprisingly found that "a composition comprising hydroxycitric acid, calcium and potassium or sodium wherein the composition is bound together to form a single molecule" produces a composition, which has desirable properties that are not present with hydroxycitric acid and a single cation. Specifically, the Applicants found that their invention is highly soluble in water while retaining minimal hygroscopicity. The solubility has obvious benefits in terms of formulating and administering the active agent. The minimal hygroscopicity is desirable because the composition doesn't hydrate in air and therefore doesn't degrade or cyclize. The claimed subject matter also unexpectedly has attractive food product qualities including neutral taste and neutral color. These findings are totally unexpected based on the prior art. Therefore, one of ordinary skill in the art could not have predicted this desirable and valuable composition and thus the invention is non-obvious.

'989 Does Not Teach or Suggest More than One Cation

The '989 also does not disclose more than one cation associated with one anion. Here the question "... is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious". MPEP 2141.02. The '989 does not teach or disclose more than one cation associated with one anion. Similarly, the '516 does not teach or disclose more than one cation associated with one anion. Thus combining the '989 with the '516, arguably cannot teach or suggest more than one cation AND one anion (it may teach or suggest more than one cation with more than one anion). However, the Applicant respectfully

insists that this is not the same as the concept of more than one cation associated with only one anion.

#### No Motivation to Combine

There must be a motivation to combine. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. MPEP § 2143.01. The Examiner is respectfully requested to indicate the source of the motivation to combine more than one cation with only one anion.

Thus combining the '516 and '989 teachings would not have resulted in the present invention. The Applicant respectfully submits that one of ordinary skill in the art, at the time of the invention, would not have considered generating "a composition comprising hydroxycitric acid, calcium and potassium or sodium" given these two teachings.

#### New Rejections

Claim 21 is rejected under 35 USC 103(a) as being unpatentable over US patent 3,764,692 to Lowenstein (hereinafter '692) in view of 5,536,516 to Moffett et al. (hereinafter '516). Claim 21 is embodied in current Claim 31 which depends on current Claim 28.

The Examiner states that "as set forth in '692 a composition comprising hydroxycitric acid, sodium or potassium, and calcium". However, the Applicant reiterates that (as stated above) the '692 does not teach this composition.

Thus, neither the '692 nor the '516 teach or suggest "a composition comprising hydroxycitric acid, calcium and potassium or sodium wherein the composition is bound together to form a single molecule". The Applicant respectfully submits that one of ordinary skill in the art, at the time of the invention, would not have considered generating "a composition comprising hydroxycitric acid, calcium and potassium or sodium" based on these two teachings.

Current Claim 31 is not obvious at the time the invention was made.

Claim 21 is also rejected under 35 USC 103(a) as being unpatentable over US patent 5,536,516 to Moffett et al. (hereinafter '516) in view of WO 98/28989 to Karppanen et al.

(hereinafter '989). Claim 21 is embodied in current Claim 31 which depends on current Claim 28. Claim 28 adds the additional constraint that the hydroxycitric acid, calcium and potassium or sodium are bound together to form a single molecule.

The Examiner states that '516 teaches snack bars but not the same concentration as set forth in the instant composition., and relies upon the '989 application for the range of cations.

However, for the reasons stated above neither the '516 nor the '989 teach or suggest "a composition comprising hydroxycitric acid, calcium and potassium or sodium or a mixture thereof wherein the composition is bound together to form a single molecule". The Applicant respectfully submits that one of ordinary skill in the art, at the time of the invention, would not have considered generating the claimed subject matter given these two teachings.

Since current Claim 31 depends from current Claim 28, this claim is not obvious at the time the invention was made.

Previous Claim 22 depended from previous Claim 12. Current Claim 30 which depends on Claim 28 embodies this claim. The Examiner indicated that this claim was directed to an invention that is independent or distinct. The Applicant disagrees. "In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application". MPEP 707.07(f). The Examiner is requested to fully explain the ground for the withdrawal from consideration.

The present response deletes claims 1-24 and adds Claims 25-44. These amendments either return the claims to the form prior to the Examiner's imposed restriction/election requirement or to a form, which is not independent or distinct from the invention originally claimed. The Applicant respectfully requests that the Examiner reconsider the imposed restriction/election requirement and examine these claims.

The Applicant has amended the current claims such that, with the exception of Claim 30, none recite a limitation to sodium and therefore have proper dependent form. Claim 30 is deemed to be in proper form. The Examiner is respectfully requested to reconsider the previous (in the office action of May 23, 2005) objection to current Claim 30.

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

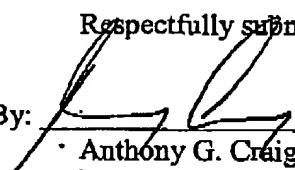
The Commissioner is authorized to charge the required fees and any underpayment of fees or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Date:

1/25/06

Respectfully submitted,

By:

  
Anthony G. Craig  
Reg. No. 50,342

FLIESLER MEYER LLP  
Four Embarcadero Center, Fourth Floor  
San Francisco, California 94111-4156  
Telephone: (415) 362-3800  
Customer No.: 23910  
acraig@fdml.com



**This Page is Inserted by IFW Indexing and Scanning  
Operations and is not part of the Official Record**

**BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☒ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** \_\_\_\_\_

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.**